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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,035	09/27/2005	Yasushi Sano	136097	4025
25944 7590 03/09/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
YANG, JIE				
ART UNIT		PAPER NUMBER		
1793				
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03/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,035

Applicant(s)

SANO ET AL.

Examiner

JIE YANG

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) 3-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claims 3-12 are withdrawn as non-elected claims and claim 1 is pending for examination. No amendments to the claims have been made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolski (US 5834140, thereafter, US'140).

US'140 is applied to the claim 1 for the same reason as stated in the previous rejection dated 7/16/2008.

Response to Arguments

Applicant's arguments filed on 11/17/2008 with respect to claim 1 have been fully considered but they are not persuasive.

Applicant's arguments are summarized as follows:

The Office Action asserts that because the copper foil disclosed by Wolski (US'140) has the claimed R_z value and the claimed percent elongation, the copper foil disclosed by Wolski

(US'140) inherently possesses the claimed mirror gloss (Gs is 100 or more). The Applicants disagree because:

A) Wolski (US'140) does not provide a measurable indicia for the disclosed "unevenness" or surface uniformity;

B) there is not necessarily a correlation between surface roughness (R_z) and surface uniformity (Gs);

C) the process of Wolski (US'140) used to make its foil is clearly different from the instant claimed process at least because Wolski (US'140) uses a glue in the electrolyte composition that is known to cause unevenness;

and D) not that all foils with the chemical percent elongation and R_z values, prepared by any other method, such as the method of Wolski (US'140), necessarily have the claimed Gs value.

Responses are as follows:

Regarding the Applicant's arguments A)-D), the Examiner notices the Applicant claims a product of electrodeposited copper foil, the Applicant has not provided evidence or data to prove that the other method, for example the process of Wolski (US'140) can not obtain Cu foil with the claimed features.

Still regarding the arguments A)-D), as pointed out in the previous office action marked 7/16/2008, Wolski (US'140) clearly teaches the copper foil has flatter surface on both surface as compared with the conventional ones (Col.1, lines 7-19 of US'140) and the copper crystal can be made fine and a plating surface having less unevenness can be obtained (Col.5, lines 7-17 of US'140). Although US'140 does not specify the degree of mirror gloss of the roughness surface, because US'140 teaches the same flat low roughness copper foil with the similar R_z (0.6-2.1 μ m) and percent elongation (10.0% or higher) at 180°C made by the similar electrodeposition process as recited in the instant invention, therefore, it is the Examiner's position that the property that surface uniformity of the foil with degree of mirror gloss of the roughness surface, measured by Gs (85°) in accordance with JIS (Japanese Industrial Standard) Z8741 is 100 or more would inherently be expected in the US'140 foil. The Examiner further notices the Applicant has not provided evidence or data to prove "...a glue in the electrolyte composition that is known to cause unevenness" as argued in the argument C).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-270-1884. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793